

Appl. No. 09/629,553

Amdt. Dated 4/16/2004

Response to Office action dated 01-29-2004

### **REMARKS**

Claims 1 - 29 are pending. Claims 11, 13, and 15 have been amended. No new claims have been added. No claims have been canceled.

#### ***Claim Rejections - 35 USC § 112***

The Examiner rejected claims 11 and 15 under 35 USC § 112 as providing insufficient antecedent basis for the feature "the window." Claims 11, 13 and 15 have been amended to depend on independent claim 10, not claim 9. Claim 10 provides antecedent basis for the feature "the window" of claims 11 and 15. Therefore, this rejection has been overcome and should be withdrawn.

#### ***Claim Rejections - 35 USC § 102***

The Examiner rejected claims 1-5, 8, 10, 17-26, and 29 under 35 USC § 102(a, e) as anticipated by Radziewicz (USP 5,854,897). This rejection is respectfully traversed.

Radziewicz is directed to transmitting and displaying advertisements to data terminal equipment (DTE) while the connection path of the DTE to a network is idle (See Radziewicz, 5:43-47). In Radziewicz, the user of the DTE must first voluntarily subscribe to the optional advertisements (See Radziewicz, 6: 39-45). Only after the user has elected to receive advertisements will advertisements be both transmitted to the DTE and displayed on a DTE display window while the connection path is idle (See Radziewicz, 7:3-17).

To anticipate a claim, the reference must teach each and every element of the claim. MPEP § 2131 provides:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. [...] The identical invention must be shown in as complete detail as is contained in the ... claim.

12/25

Appl. No. 09/629,553

Amdt. Dated 4/16/2004

Response to Office action dated 01-29-2004

**Claim 1 and 22:**

Claims 1 and 22 are independent. Claim 1 recites, among other features, "a client application on a local device." The Examiner contends that Radziewicz shows "a client application (24, 26) on a local device (14)." The Examiner characterizes the combination of Radziewicz's modified network server software (24), which is located at the Network Service Provider (16), and the Modified Browser Client Software (26), which is located at the DTE (14), as analogous to the claimed client application. Radziewicz's Modified Network Server Software (24) does not reside on the local device. Therefore, the combination of the Modified Browser Client Software (26) on a DTE (14) and the Modified Network Server Software (24) on the Network Service Provider (16) does not teach "a client application on a local device." Since Radziewicz does not teach each and every element of claim 1, Radziewicz does not anticipate claim 1. Therefore, the rejection should be withdrawn.

In addition, claim 1 recites, among other features, "the client application activating." The Examiner further contends that Radziewicz shows "a client application activating (the client application comprising of both the modified network server software 24, and modified browser client software 26 shown in Fig. 8A, 5:35-38)." Because the Examiner asserts that the client application is a combination of both the modified network server software 24 and modified browser client software, this combination cannot teach the claimed feature "the client application activating," as the claim recites "a client application on a local device." Since Radziewicz does not teach each and every element of claim 1, Radziewicz does not anticipate claim 1. Therefore the rejection should be withdrawn.

In addition, claim 1 recites, among other features, "the client application monitoring the user's interaction with the local device with respect to the client application and thereby detecting whether the user is interacting with the online service." The Examiner further contends that Radziewicz shows "the client application (24) monitoring the user's (DTE) interaction with the local device (14) with respect to the client application (26 at 14) and thereby detecting whether the user is interacting with the online service (12) (6:13-18)." Radziewicz discusses the modified network

13/25

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Response to Office action dated 01-29-2004

server software (24) monitoring traffic to and from the DTE to determine if the connection path is idle (See Radziewicz, 6:13-18). Radziewicz describes "idle" as the time when "a device connected to a computer or other network device by a transmission or communications medium is not presently sending or receiving any information over the transmission medium" (See Radziewicz, 3:57-63). However, the cited portion of Radziewicz fails to teach "the client application monitoring the user's interaction with the local device with respect to the client application and thereby detecting whether the user is interacting with the online service," as recited in claim 1. Radziewicz teaches monitoring network traffic between the DTE and the network. This network traffic monitoring does not teach "the client application monitoring the user's interaction with the local device with respect to the client application and thereby detecting whether the user is interacting with the online service," as recited in claim 1. Moreover, the specification at page 34, line 6 describes "[u]ser interaction" as comprising "a user manipulating a computer input device, such as a keyboard or mouse, with respect to local device." Since Radziewicz's monitoring is pertinent to network transmission idleness, Radziewicz does not teach "monitoring the user's interaction with the local device," as recited in claim 1. Since Radziewicz does not teach each and every element of claim 1, Radziewicz does not anticipate claim 1. Therefore the rejection should be withdrawn.

In addition, claim 1 recites, among other features,

if the user has not interacted with the local device with respect to the client application for a predetermined amount of time, the client application causing a dialog to be displayed on the output device of the local device, wherein the dialog notifies the user that the user has been inactive with respect to the online service, and wherein a display associated with a resource locator is displayed in the dialog.

The Examiner further contends that Radziewicz shows

if the user has not interacted with the local device (14) with respect to the client application (20, 24) for a predetermined time, the client application (26) causing a dialog (Fig. 8A-8D, 66, 76, 82, 84) to be displayed on the output device of the local device (14), wherein the dialog notifies the user that the user has been idle with

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Response to Office action dated 01-29-2004

respect to the online server (12, 20) by displaying resource locator in the dialog (5:46-6:6, 12:23-45).

The claim language does not recite "idle" as defined in Radziewicz. The claim language recites "inactive." As set forth above, Radziewicz's "idle" involves perceiving a lack of network traffic and is fundamentally different from "the dialog notifies the user that the user has been inactive with respect to the online server" as claimed.

Moreover, the claim language does not recite "by displaying resource locator in the dialog," as stated by the Examiner. The claim recites "wherein a display associated with a resource locator is displayed in the dialog." In contrast, Radziewicz describes transmitting and displaying advertisements when the communication link is "idle" (See Radziewicz, 5:43 - 6:6). Additionally, Radziewicz, describes click-throughs when a user actively clicks on a button (See Radziewicz, 12:23-43). The Examiner has not addressed "the client application causing a dialog to be displayed on the output device of the local device," as recited in claim 1. Therefore, the Examiner's characterization of Radziewicz fails to teach the claimed feature.

Since Radziewicz does not teach each and every element of claim 1, it is respectfully requested that the rejection be withdrawn and claim 1 be allowed to issue. Further, all claims depending on claim 1 are patentable over Radziewicz for the same reasons.

To the extent that claim 22 has features similar to claim 1, the arguments set forth for claim 1 are applicable to claim 22. Therefore, claim 22 is patentable over Radziewicz for the same reasons as set forth in claim 1. Further, all claims depending on claim 22 are patentable over Radziewicz for the same reasons as set forth in claim 1.

**Claims 2, 3, 5, 8, 23, 24, 26, and 29:**

Dependent claims 2, 3, 5, 8, 23, 24, 26, and 29 are patentable over Radziewicz by virtue of their dependency on claims 1 or 22. In addition, some of the dependent claims recite other patentable features as set forth below.

15/25

Appl. No. 09/629,553

Amdt. Dated 4/16/2004

Response to Office action dated 01-29-2004

**Claims 3 and 24:**

The Examiner contends that Radziewicz teaches

the display of at least one advertisement (announcement) operates in accordance with a first play list (sequence of messages 9:38-39), the first play list comprising at least one ad object, each ad object comprising a resource locator for a given advertisement, a resource locator for click-through associated with the given advertisement (12:26-45), at least one display attribute for the given advertisement, the first play list further specifying an order in which the advertisements are to be displayed (9:1-33).

However, in this statement, the Examiner did not address the feature “at least one display attribute for the given advertisement” as recited in claims 3 and 24. Radziewicz discusses the announcement server’s audio, video, and clock features, but does not teach “the first play list further specifying an order in which the advertisements are to be displayed” as recited in claims 3 and 24 (See Radziewicz, 9:1-33). More specifically, Radziewicz fails to teach the following features of claims 3 and 24:

the display of at least one advertisement operates in accordance with a first play list, the first play list comprising at least one ad object, each ad object comprising a resource locator for a given advertisement, a resource locator for a click-through associated with the given advertisement, and at least one display attribute for the given advertisement, the first play list further specifying an order in which the advertisements identified in the play list are to be displayed.

As such, Radziewicz does not teach each and every element of claim 3 or claim 24. Therefore claims 3 and 24 are patentable over Radziewicz and the rejections should be withdrawn. Further, all claims depending on claims 3 and 24 are patentable over Radziewicz for the same reasons.

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Response to Office action dated 01-29-2004

**Claims 4 and 25:**

In addition to being patentable over Radziewicz because of their dependence on claims 3 and 24, respectively, claims 4 and 25 recite other patentable features.

The Examiner contends that Radziewicz shows

client application pausing the play list if the user has not interacted with the local device with respect to the client application (24) for an amount of time (16:18-23, Fig. 3D, 15:30-35); a storage area for recoding a log of advertisements messages that were already transmitted to the users for futures use in selecting advertisement to display when connection is re-established.

The first cited portion of Radziewicz discusses the timer functionality of setting a maximum display time per advertisement and monitoring if the user aborted or terminated the session (See Radziewicz, 16:18-23). The second cited portion of Radziewicz is related to the user aborting or terminating the session (See Radziewicz, Fig. 3D and 15:30-35). Neither of the cited portions of Radziewicz teach "the client application pausing the play list if the user has not interacted with the local device with respect to the client application for the predetermined amount of time," as recited in claims 4 and 25. Since Radziewicz does not teach each and every element of claim 4 or claim 25, claims 4 and 25 are patentable over Radziewicz. Therefore, it is respectfully requested that the rejections be withdrawn and claims 4 and 25 be allowed to issue.

**Claim 10:**

Claim 10 comprises among other features "a client application activating" and "detecting whether the user is interacting with the online server." These features of claim 10 are also recited in claim 1. To the extent claim 10 has features similar to claim 1, the arguments posited in claim 1 apply to claim 10. Therefore, claim 10 is patentable over Radziewicz for at least the same reasons as set forth in claim 1.

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Response to Office action dated 01-29-2004

In addition, the Examiner contends that Radziewicz shows "the client application removing the window from the output device of the local device if the user has not interacted with the window for a predetermined amount of time (executing a logout procedure, 15:30-35, Fig. D)." The cited portion of Radziewicz refers to an "abort" procedure executed by the user and a "logout" procedure which logs "all relevant information about advertisement messages that were transmitted . . ." (See Radziewicz, 15:30-35 and Fig. D). Radziewicz's user abort process and logging relevant information about advertisement messages transmitted is unrelated to and does not teach "the client application removing the window from the output device of the local device if the user has not interacted with the window for a predetermined amount of time," as recited in claim 10. Since Radziewicz does not teach each and every element of claim 10, claim 10 is patentable over Radziewicz. Therefore, the rejection should be withdrawn and claim 10 should be allowed to issue.

**Claim 17:**

Claim 17 is independent. The Examiner rejected claim 17 for the same reasons as claims 1, 3 and 4. To the extent claim 17 has features similar to claims 1, 3, and 4, the arguments set forth above for claims 1, 3, and 4 are applicable to claim 17. Therefore, claim 17 is patentable over Radziewicz for the same reasons as claims 1, 3, and 4. Thus, the rejection should be withdrawn and claim 17 should be allowed to issue. Further, all claims depending on claim 17 are patentable over Radziewicz for the same reasons.

**Claims 18, 19, and 20:**

In addition to being patentable over Radziewicz because of its dependence on claim 17, claims 18, 19, and 20 recite other patentable features.

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Response to Office action dated 01-29-2004

**Claim 20:**

The Examiner contends that Radziewicz shows "the client application closing the communication channel if the user has not interacted with the local[] device with respect to the client application (24) for a[] [predetermined] amount of time (16:9-26)." However, the cited portion of Radziewicz discusses (1) a timer option to determine if the time displaying advertisements has exceeded a maximum amount of display time, and (2) determining if the user has executed an "abort" procedure which results in a "logout" procedure that logs "all relevant information about advertisement messages that were transmitted . . ." (See Radziewicz 16:9-26). Radziewicz's user abort process and logging relevant information about advertisement messages transmitted are unrelated to and do not teach "the client application removing the window from the output device of the local device if the user has not interacted with the window for a predetermined amount of time," as recited in claim 20. Since Radziewicz fails to teach the claimed feature, claim 20 is patentable over Radziewicz and claim 20 should be allowed to issue.

**Claim 21:**

Claim 21 is dependent on claim 20. Therefore, by virtue of its dependency on claim 20, claim 21 is not anticipated by Radziewicz and should be allowed to issue for the same reasons as claim 20.

***Claim Rejections - 35 USC § 103***

**Claims 6, 7, 27, and 28:**

The Examiner rejected claims 6, 7, 27, and 28 under 35 USC § 103 as obvious from Radziewicz et al. (USP 5,854,897) in view of Tazoe et al (USP 6,326,985). This rejection is respectfully traversed.



Appl. No. 09/629,553

Amdt. Dated 4/16/2004

Response to Office action dated 01-29-2004

Tazoe is directed to a method of controlling the display screen of a computer (See Tazoe, 2:40-43). When the mouse cursor is located within a window for a predetermined time, the window is considered "active" and the standard content of that window is displayed (See Tazoe, 15:12-24). When the mouse cursor is located outside of a window for a predetermined time, the window is considered "inactive" and the standard content of that window is not displayed (See Tazoe, 15:45-54). In the inactive window, either in the background or the periphery of the active window, an alternate message may be displayed (See Tazoe, 15:54-61, 1:66-2:6).

Combining Radziewicz and Tazoe would result in a system where (1) the network service provider determines if the data communication line between the user computer and content providers is idle (See Radziewicz, 6:13-19), (2) if so, transmitting an advertisement file to the user computer (See Radziewicz, 5:51-54), (3) displaying the advertisement on the user computer (See Radziewicz, 5:54-56), (4) the user computer determining the position of the mouse cursor (See Tazoe, 14:53-59), (5) if the mouse cursor resides in a window for a predetermined period of time, deeming that window "active" and displaying the content of the active window (See Tazoe, 15:12-24), and (6) if the mouse cursor resides outside a window for a predetermined period of time, deeming that window "inactive" and displaying a message in the inactive window either in the background or the periphery of the active window (See Tazoe, 15:45-61, 1:66-2:6). This does not teach what is claimed.

The Examiner contends that it would have been obvious to one of ordinary skill in art at the time the invention was made to combine the teachings of Radziewicz and Tazoe because "determining inactivity with respect to the last time user 'clicked' in a window . . . is well known in the art, and would have been an obvious modification to the system disclosed by Radziewicz as evidenced by Tazoe."

"To establish a *prima facie* case of obviousness, [. . .] the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP 706.02(j)*. Even if, in arguendo, the features of Radziewicz and Tazoe were combinable, they would still fail to teach each and every feature of the claimed invention.

20/25

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Respons to Office action dated 01-29-2004

Claim 6 includes the feature

the client application determines that the user has not interacted with the local device with respect to the client application for a predetermined amount of time if the user has not clicked on an advertisement in the client window within the predetermined amount of time.

The Examiner contends that Tazoe shows "a system for determining inactivity of a client application by detecting dispatch message indicating mouse input in a client application window or an icon located in a predetermined area of the screen (13:62-14:15 and 15:4-56)." In Tazoe, if the mouse cursor is in a window for a predetermined time or clicks in the window then the window is deemed active (See Tazoe, 13:65-14:15 and 15:4-56). Additionally, Tazoe describes inactivity as when

the predetermined time period [has] elapsed after the exit of the mouse cursor from the application window, it is believed that the focus or the interest of the user to this application is completely lost. That is, it means that the application window is fallen into the inactive state

(See Tazoe, 15:47-52). Tazoe's determination of inactivity requires that the mouse cursor be moved outside of the application window and remain outside the application window for a predetermined time. Therefore, Tazoe's determination of inactivity is fundamentally different than and does not teach or suggest the recited feature, "if the user has not clicked on an advertisement in the client window within the predetermined amount of time," of claim 6. Since each and every element of claim 6 is not taught by the combination of Radziewicz and Tazoe, claim 6 is patentable over Radziewicz in view of Tazoe. Hence, the rejection should be withdrawn and claim 6 should be allowed to issue.

Claim 7 is dependent from claim 6. Therefore, by virtue of its dependence on claim 6, claim 7 is patentable over Radziewicz in view of Tazoe, the rejection should be withdrawn, and claim 7 should be allowed to issue.

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Response to Office action dated 01-29-2004

To the extent claim 27 has features similar to claim 6, the arguments set forth regarding claim 6 apply to claim 27. Therefore, claim 27 is patentable over Radziewicz the same reasons as set forth regarding claim 6.

Claim 28 is dependent from claim 27. Therefore, by virtue of its dependence on claim 27, claim 28 is patentable over Radziewicz in view of Tazoe, the rejection should be withdrawn, and claim 28 should be allowed to issue.

**Claims 9, 11-16:**

The Examiner rejected claims 9 and 11-16 under 35 USC § 103 as obvious from Radziewicz et al. (USP 5,854,897) in view of knowledge known to one of ordinary skill in the art. This rejection is respectfully traversed.

**Claim 9:**

Claim 9 is dependent from claim 1. As set forth above in the argument regarding the § 102 rejection of for claim 1, Radziewicz fails to teach each and every element of claim 1. Since claim 9 is dependent on claim 1, Radziewicz fails to teach each and every limitation of claim 9. Therefore, claim 9 is not obvious in view of Radziewicz in further view of "knowledge known to one of ordinary skill in the art." Thus, the rejection should be withdrawn and claim 9 should be allowed to issue.

**Claims 11, 12, 13, 15, and 16:**

Claims 11, 12, 13, 15, and 16 are dependent from claim 10. As set forth above in the argument regarding the § 102 rejection of claim 10, Radziewicz fails to teach each and every element of claim 10. Moreover, the Examiner has not set forth how "knowledge known to one of ordinary skill in the art" is both combinable with Radziewicz and teaches the features of claim 10 which Radziewicz fails to teach. The Examiner has failed to show how "knowledge known to one of

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Response to Office action dated 01-29-2004

ordinary skill in the art” cures the deficiencies of Radziewicz. Therefore, claims 11, 12, 13, 15, and 16 are not obvious in view of Radziewicz in further view of “knowledge known to one of ordinary skill in the art.” Thus, the rejection should be withdrawn and claims 11, 12, 13, 15, and 16 should be allowed to issue.

**Claim 12:**

The Examiner contends that Radziewicz shows “[after the client window has been removed] from display (log out) [on the local device], the client application (26) re-displaying the client window (66) on the output device [of the local device] if the user interacts with the browser application (13:45-46).” The cited portion of Radziewicz describes the logout procedure, triggered when the user aborts the session, and then logs or records all relevant information about the advertising messages that were transmitted (See Radziewicz, 15:29-35). Radziewicz’s user abort process and logging relevant information about advertisement messages transmitted is unrelated to “the client application removing the window from the output device of the local device if the user has not interacted with the window for a predetermined amount of time,” as recited in claim 12. Since Radziewicz fails to teach the claimed feature, claim 12 is patentable over Radziewicz in view of “knowledge known to one of ordinary skill in the art.” Therefore, the rejection should be withdrawn and claim 12 should be allowed to issue.

**Claim 13:**

To the extent that the features of claim 13 are similar to claims 3 and 34, the arguments set forth for claims 3 and 24 concerning the § 102 rejection are applicable to claim 13. As shown, Radziewicz fails to teach each and every feature of claim 13. Since the Examiner has not provided any arguments as to how of “knowledge known to one of ordinary skill in the art” cures the deficiencies of Radziewicz, claim 13 is not obvious in view of Radziewicz in further view of “knowledge known to one of ordinary skill in the art.” Therefore, the rejection should be withdrawn and claim 13 should be allowed to issue.

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Response to Office action dated 01-29-2004

**Claim 14:**

In addition to being patentable over Radziewicz in view of "knowledge known to one of ordinary skill in the art," by virtue of its dependency on claim 13, claim 14 recites other patentable features

To the extent the features of claim 14 are similar to the features of claims 4 and 25, the arguments set forth for claims 4 and 25 regarding the § 102 rejections are applicable to claim 14. As such, Radziewicz fails to teach each and every feature of claim 14. Since the Examiner has not set forth any arguments as to how "knowledge known to one of ordinary skill in the art" cures the deficiencies of Radziewicz, claim 14 is not obvious in view of Radziewicz in further view of "knowledge known to one of ordinary skill in the art." Therefore, the rejection should be withdrawn and claim 14 should be allowed to issue.

**Claim 16:**

The Examiner contended that Radziewicz shows "the displaying of a window (84) on top of another window on the output device after an idle time (Fig. 8D, 24:46-66)." Radziewicz's "idle" is described as the time when "a device connected to a computer or other network device by a transmission or communications medium is not presently sending or receiving any information over the transmission medium" (See Radziewicz, 3:57-63). Moreover, when Radziewicz is "idle", advertisements are downloading and displaying. However, claim 16 recites "the client application allows other windows to be displayed on top of the client window if the user has not interacted with the client window within the predetermined amount of time." Radziewicz's idle is fundamentally different than the claimed feature "if the user has not interacted with the client window within the predetermined amount of time." As such, Radziewicz fails to teach each and every element of claim 16. Therefore claim 16 is not obvious in view of Radziewicz in further view of "knowledge known

Appl. No. 09/629,553  
Amdt. Dated 4/16/2004  
Response to Office action dated 01-29-2004

to one of ordinary skill in the art," the rejection should be withdrawn and claim 16 should be allowed to issue.

***Conclusion***

It is submitted, however, that the independent and dependant claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy and because agreement was reached with the Examiner as described above, the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: April 16, 2004

  
\_\_\_\_\_  
Joe G. Landau, Reg. No. 54,732

SoCal IP Law Group  
310 N. Westlake Blvd., Suite 120  
Westlake Village, CA 91362  
Telephone: 805/230-1350  
Facsimile: 805/230-1355  
email: info@socalip.com

25/25